

aware of a different Information Disclosure Statement, applicant will make further attempts to locate this document.

As an initial matter, applicant wishes to bring attention to the Examiner that there is currently litigation pending on a related patent (Civil Action No. C 00 1156 DLJ) in the United States District Court for the Northern District of California. Applicant is currently in the process of gathering information for disclosure in the pending application, and will submit a supplemental Information Disclosure Statement in the near future, if any relevant information is discovered. Therefore, the Examiner may wish to postpone further action the merits pending receipt of this supplemental Information Disclosure Statement.

Response to Rejection Under 35 U.S.C. §102(b)

Claims 21-51 stand rejected under 35 U.S.C. §102(b) as being clearly anticipated by Bigstar.com (<http://bigstar.com>).

Applicant respectfully submits that the cited Bigstar.com web site does not qualify as prior art under 35 U.S.C. §102. The present application is a continuation of U.S. Patent Application Serial No. 08/741,915, filed October 31, 1996 (now U.S. Patent No. 5,963,916). This parent application (“‘915 application”) was itself a continuation of several other applications that claim a priority date back to September 13, 1990. Therefore, the effective filing date of the present application is at least October 31, 1996.

Submitted herewith, as Exhibit B, is a copy of the transmittal letter that was filed with the present application, and which indicates that this application is a continuation of U.S. Patent Application Serial No. 08/741,915. Also included is a copy of the first preliminary amendment filed on October 5, 1999 that includes a request change the specification to reflect the status of the application as a continuation of U.S. Patent Application Serial No. 08/741,915.

The Bigstar.com web site is a web site that allows users to download video content, such as video clips from movies. No effective date of the Bigstar.com reference was provided. However, an investigation of the Bigstar.com web site indicates that the Bigstar Entertainment company was founded in 1998. A copy of corporate profile web page from the Bigstar.com web site is provided in Exhibit C. Therefore, the effective date of the Bigstar.com site is after January 1998. Thus, applicant respectfully submits that the cited reference does not qualify as prior art (under §102(b) or otherwise) against the pending claims given their October 31, 1996 effective

filing date, and applicant respectfully requests that the Examiner withdraw the instant rejection of clear anticipation.

As evidenced by the documents provided in Exhibit B, this present application (Serial Number 09/412,404) claims priority from U.S. Patent Application No. 08/741,915 (the '915 application"), filed October 31, 1996, now U.S. Patent No. 5,963,916. The pending claims correspond to the claims of the parent application in being directed to methods for enabling, and network web sites for allowing, remote users to preview portions of various audiovisual information. The pending claims 21-51 are directed to previewing portions of "video product" information or "written work" information, whereas the parent application and the issued '916 patent claims are directed to previewing "music product" information. With respect to the requirements necessary to satisfy 35 U.S.C. §120, the parent '915 application and the instant application both share a common inventor, Joshua D. Kaplan (the *only* inventor in both), and they also satisfy the continuity of pendency requirement. Furthermore, continuity of disclosure between the present application and the '915 application can be readily established for both the "video product" claims (claims 21-38) and the "written work" claims (claims 39-51).

Claims 21-38 of the present application are directed to methods for enabling a remote user to preview a portion of a pre-recorded video product. Support for these claims is present in both the specification of the present application as well as in the parent application filed in 1996. Specifically, support for these claims can be found in the parent '915 application, now U.S. Patent Application No. 5,963,916, at Column 18, line 10 through line 54. This description includes disclosure of a video rental embodiment that allows a user to download portions of movie videos from the network web site or stand-alone kiosk embodiments. Therefore, claims 21-38 of the present application are entitled to a filing date prior to the effective date of the cited reference.

Claims 39-51 of the present application are directed to methods for enabling a remote user to preview portions of written works. Support for these claims is present in both the specification of the present application as well as in the parent application filed in 1996. Specifically, support for these claims can be found in the parent '915 application, now U.S. Patent Application No. 5,963,916, at Column 14, lines 26 through 34, and Figs. 10 and 34E, as well as at column 17, lines 36 through 39, and Figure 38. This description includes disclosure of a written work embodiment that allows a user to download portions of magazines or magazine

articles from a network web site. Therefore, claims 39-51 of the present application are entitled to a filing date prior to the effective date of the cited reference.

Moreover, with respect to claims 39-51, the Bigstar.com site does not teach or suggest allowing a remote user to preview or download written information at all. As seen on their web site, the Bigstar.com is directed to the preview and download of video information only. Thus, the cited reference does not teach or suggest a "method for enabling a remote user to preview a portion of a written work" as claimed in claims 39-43, nor a "web site for allowing a remote user to preview a pre-selected portion of a written work" as claimed in claims 44-51. Therefore, it is respectfully submitted that claims 39-51 are patentable under 35 U.S.C. §102(b) in view of the cited reference.

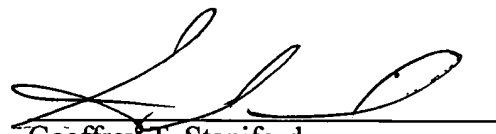
In view of the remarks provided herein, applicant respectfully submits that claims 21-51 are patentable under 35 U.S.C. §102(b) over the cited Bigstar.com reference.

If there are any additional charges, please charge them to our Deposit Account Number 04-0822.

Respectfully submitted,
DERGOSITS & NOAH LLP

Dated: September 4, 2001

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